

REMARKS

The Pending Claims

Claims 1, 4, 6-9, 12, and 14-16 are pending and are directed to an adhesive composition for application to skin.

Amendments to the Claims

The phrase "carboxylic acid ester" of independent claims 1 and 9 has been amended to read "triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms" as recited in dependent claims 3 and 11, respectively. Claims 2, 3, 5, 10, 11, and 13 have been cancelled as superfluous in view of the amendments to claims 1 and 9. Accordingly, no new matter has been added by way of these amendments.

Summary of the Office Action

The Examiner has rejected claims 1 and 9 under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 4,608,249 (Otsuka et al., hereinafter "the '249 patent"). The Examiner has also rejected claims 2-8 and 10-16 under 35 U.S.C. § 103(a) as allegedly obvious over the '249 patent in combination with U.S. Patent No. 5,876,745 (Muraoka et al., hereinafter "the '745 patent") or U.S. Patent No. 6,139,867 (Muraoka et al., hereinafter "the '867 patent"). Additionally, the Examiner has provisionally rejected claims 1-16 for obviousness-type double patenting as being unpatentable over copending U.S. Patent Application No. 10/317,076 (Murakami et al., hereinafter "the '076 application"). Reconsideration of the pending claims is respectfully requested.

Discussion of the Anticipation Rejection

The Examiner has rejected claims 1 and 9 under 35 U.S.C. § 102(b) as allegedly anticipated by the '249 patent. Applicants traverse this rejection for the following reasons.

The pending claims of the present invention recite an adhesive composition for application to the skin comprising predetermined amounts of a given acrylic copolymer and a "triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms." The triglycerine ester is a liquid or paste at room temperature, and the acrylic copolymer has a predetermined gel fraction. The present application teaches that (a) addition of the triglycerine ester to the inventive composition is crucial to suppress the adverse effect on adhesiveness resulting from perspiration (see, e.g., Comparative Example 1, Table 1, and page 25, line 19 - page 26, line

8) and (b) control of the gel fraction of the acrylic copolymer improves internal cohesive force of the adhesive layer while reducing skin irritation (see, e.g., page 12, lines 22-32, and page 13, line 31 – page 14, line 5).

In contrast, the therapeutic material disclosed in the '249 patent does not contain a "triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms" as recited in the pending claims. The closest example in the '249 patent was cited by the Examiner and only involves the use of ethyl acetate as an adjuvant (Example 3). Additionally, the '249 patent does not disclose adjusting the gel fraction of a copolymer to the range recited in the pending claims. Accordingly, the '249 patent does not teach all of the elements present in the rejected claims, and, therefore, the '249 patent does not anticipate claims 1 and 9. In view of the foregoing, the present invention as defined by the pending claims is novel in view of the '249 patent, and the anticipation rejection should be withdrawn.

Moreover, the '249 patent does not render the present invention obvious. Nothing in the '249 patent teaches or suggests using a triglycerine ester to suppress the decrease in adhesiveness of an acrylic copolymer-containing composition during perspiration. Without such a suggestion, one of ordinary skill in the art would not be motivated to modify the material disclosed in the '249 patent in order to arrive at the present inventive composition. Accordingly, the present invention as defined by the pending claims also is unobvious in view of the '249 patent.

Discussion of the Obviousness Rejection

The Examiner has rejected claims 2-8 and 10-16 under 35 U.S.C. § 103(a) as allegedly obvious over the '249 patent in combination with the '745 patent or the '867 patent. Applicants traverse this rejection for the following reasons.

As discussed above in connection with the anticipation rejection, the '249 patent does not teach or suggest the "triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms." The '249 patent also does not disclose adjusting the gel fraction of a copolymer to the range recited in the pending claims. Additionally, as acknowledged by the Examiner, the '249 patent does not teach the use of the specified triglycerine esters (claims 4, 6, 12 and 14) or a crosslinking agent to chemically crosslink the composition of the present invention (claims 7, 8, 15, and 16). The Examiner points to the '745 and '867 patents to remedy these deficiencies.

The '745 and '867 patents are directed toward medical adhesive sheets and teach only the genus of glycerol esters as liquid organic components used to plasticize the pressure-sensitive acrylic polymer adhesive layer. No preferable embodiments are specified, and no

examples are given wherein a glycerol ester is used. In fact, the '745 and '867 patents suggest the use of isopropyl myristate, diethyl sebacate, octyl palmitate, ethyl oleate, diethyl phthalate, and diisopropyl adipate as preferred long chain fatty acid esters to control skin irritation, not the triglyceryl caprylate, triglyceryl caprate, or triglyceryl 2-ethylhexanoate of the present invention. The '745 and '867 patents disclose the crosslinking agents used in the present invention; however, neither patent teaches adding a triglycerine ester to suppress the decrease in adhesiveness during perspiration or adjusting the gel fraction of an acrylic copolymer to the predetermined range of the present invention. As such, the '745 and '867 patents fail to remedy the deficiencies of the '249 patent.

Furthermore, the '745 and '867 patents are directed towards a support laminated with a pressure-sensitive acrylic polymer layer formed on a porous sheet, not the adhesive composition for application to skin with the aim at improving adhesive force during perspiration. Therefore, the teachings of the '745 and '867 patents would not motivate one of ordinary skill in the art to combine the crosslinking agent and glycerol ester organic liquid with the therapeutic material of the '249 patent to form an adhesive composition, let alone an adhesive composition comprising a "triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms" as recited by the pending claims. Indeed, the only way in which the combined disclosures of the '249, '745, and '867 patents might be considered as teaching or suggesting the present invention is through the use of hindsight, i.e., with the knowledge of the present application and the invention as claimed therein. It is impermissible for the Patent Office to engage in hindsight reconstruction of the claimed invention using Applicants' composition as a template and selecting elements from references to fill the gaps. See *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

Accordingly, the cited references, either alone or in combination, do not teach or suggest the present invention as defined by the pending claims. Under the circumstances, the obviousness rejection should be withdrawn.

Discussion of the Obviousness-Type Double Patenting Rejection

The obviousness-type double patenting rejection is provisional because the '076 application has not yet issued as a patent. As stated in M.P.E.P. § 1504.06, "[i]f a provisional double patenting rejection (of any type) is the only rejection remaining in two conflicting applications, the examiner should withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent." The present application has a filing date of August 29, 2001, whereas the '076 application has a filing date of December 12, 2002. Thus, if the aforementioned rejections have been

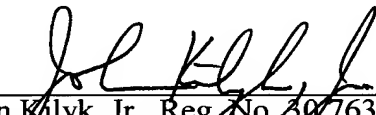
In re Appln. of Murakami et al.
Application No. 09/941,972

overcome, then the present application should be passed to issuance without the need to address the obviousness-type double patenting rejection. If appropriate, an obviousness-type double patenting rejection may be raised in the prosecution of the '076 application. In such an event, applicants will address the obviousness-type double patenting rejection at that time in connection with the prosecution of the '076 application.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



John Kilyk, Jr., Reg. No. 30,763
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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